

## REMARKS

### State of the Claims

Claim 34 has been amended to more particularly point out and clarify Applicants' invention. For example, an upper limit of 31.5% has been claimed for the brew solids yield.<sup>1</sup> Also, the Delta Standard Yield has been changed from 10% to 8%.<sup>2</sup> No new matter has been added, and all amendments are fully supported by the specification.

None of the other remaining claims have been amended in this response.

### 35 U.S.C. § 112 Rejection

Claims 9-34 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner states that the specification discloses a Delta Standard Yield of less than 8%. Also, the Examiner contends that no upper limit of 30% is set forth for the brew solids.

Applicants have amended Claim 34 to reflect Applicants' brew solids yield upper limit of 31.5% and their Delta Standard Yield of 8%.<sup>3</sup> These amendments are fully supported by the specification, and no new matter has been added.

Therefore, Applicants request that the Examiner reconsider and then allow Claims 9-34 over the Examiner's 35 U.S.C. § 112, first paragraph, rejection.

### 35 U.S.C. § 102(b) Rejection

Claims 9-13 and 18-34 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent Application JP 9-198570 (Sakata, et al.).

The Examiner states that Sakata '570 discloses a process wherein a coffee extract is prepared in a vending machine, stored for a period of time (e.g., 30 minutes), and diluted within Applicants' ranges. In addition, the Examiner asserts that the strength of the coffee may be adjusted based upon the preference of the customer using the vending machine. The Examiner concludes by stating that it would be inherent for Sakata '570's brew solids to fall within Applicants' ranges.

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<sup>1</sup> Applicants' Specification: page 10, lines 30-31 (Example 3).

<sup>2</sup> Id. at page 5, lines 3-4.

According to MPEP § 2131 a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim. The elements must be arranged as required by the claim.

Applicants' respectfully disagree with the Examiner's contentions. First, Applicants' assert that Sakata '570 does not teach or provide as an element the ability to control the strength of its coffee--either by the customer or the operator. In fact, Sakata '570 clearly indicates that their dilution mechanism is an unalterable preset that cannot be manipulated either by a customer or by an operator; e.g., "[T]he beverage with a 2x concentration is diluted two times, and the beverage with a 3x concentration is diluted three times."<sup>4</sup>

Applicants further contend that the term "preference" as used on page 9, middle paragraph, of Sakata '570 concerns a customer's preference for the size of the cup that is desired, rather than from a customer's alleged desire to manipulate the strength of the coffee flowing from the vending machine. This assertion is based upon the following: 1) strength control is not explicitly disclosed as an element at any place within Sakata '570; 2) when read in context, the term "preference" at page 9 of Sakata '570 relates to the vending machine's ability to add more extract if needed after a customer's preference has been rendered, the vending machine has searched its extract inventory, and finally the vending machine creates more extract to meet the customer's preference (i.e., size of the cup) if necessary; and 3) strength is expressly taught against when at page 6, lines 4-6, it is clear that the vending machine is preset to dilute extract at whatever concentration it is created; e.g., an extract that has a 2x concentration is diluted two times, or a 3x concentration is diluted three times, and so forth.<sup>5</sup>

In an interview between the Examiner, Applicant (Roger Gutwein) and Applicant's Attorney (Theodore P. Cummings, Esq.) on June 12, 2003, the Examiner agreed with Applicant and Applicant's Attorney that Sakata '570 indeed did not teach strength control. The reasoning for such agreement derives from the proper interpretation of Sakata '570 noted herein and communicated to the Examiner at the above-noted interview. Therefore, the strength control element is missing and Sakata '570 should be withdrawn as a reference against Applicants' claims.

Applicants therefore request reconsideration and allowance of Claims 9-13 and 18-34 over the 35 U.S.C. § 102(b) rejection.

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<sup>3</sup> Id.

<sup>4</sup> Japanese Patent Application No. JP 9-198,570: page 6, lines 4-6.

35 U.S.C. § 103 Rejection

Claims 9-13 and 18-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sakata '570.

Applicants respectfully assert that the Examiner's contentions regarding brew solids and Delta Standard Yield notwithstanding, Sakata '570 teaches away from Applicants' invention. Not only does Sakata '570 not teach strength control, as explained fully in the previous section, but also, Sakata '570 teaches that their dilution mechanism is a preset that cannot be altered by a customer or operator to determine the strength of a cup of coffee. Rather, if the concentration of the extract in the vending machine of Sakata '570 is 2x, it will be diluted two times, and so forth.

This fact expressly teaches away from Applicants' invention since strength control is integral to the operation of their invention. Further, it is improper to use one or more references where the references teach away from Applicants' invention.<sup>6</sup> In an interview held on June 12, 2003, both the facts that 1) '570 does not teach strength control and 2) that '570 in fact teaches away from Applicants' invention were discussed and agreed to between the Examiner, Applicant and Applicants' Attorney. The interview held on June 12, 2003 expressly concerned Patent Application No. 09/638,566 (P&G Case No. 7727M) which is a related case to this case and considers Sakata '570 prominently. Therefore, Applicants' believe that their reference to the June 12, 2003 interview is entirely appropriate since it concerns the issue of the relevance of Sakata '570 to Applicants' technology in this case and in U.S. Patent Application No. 09/638,566.

Applicants therefore request reconsideration and allowance of Claims 9-13 and 18-34 over the 35 U.S.C. § 103 rejection.

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<sup>5</sup> Id.

<sup>6</sup> In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

SUMMARY

The rejections in the Office Action have been discussed and, Applicants believe, the proper amendments have been set forth to address the rejections.

In light of both the amendments and the discussions contained herein, Applicants respectfully request reconsideration of the rejection and its withdrawal.

Issuance of a Notice of Allowance at an early date is earnestly solicited.

Respectfully submitted,

ROGER WILLIAM GUTWEIN, ET AL.

By: 

Theodore P. Cummings, Esq.  
Attorney for Applicants  
Registration No. 40,973  
(513) 634-1906

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